

## REMARKS/ARGUMENTS

The Examiner is thanked for the final Office Action mailed July 11, 2006. The status of the application is as follows:

- Claims 1-5, 19-21 and 28-30 are pending; and
- Claims 1-5, 19-21 and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Park (US 2003/0158922).

The rejection is discussed below.

### Preliminary Matters

The subject Office Action does not establish a *prima facie* case of anticipation because it does not identify which features of the prior art correspond to the claimed elements and limitations. Rather, Office Action broadly cites to 18 paragraphs of Park, namely paragraphs [0032]-[0049], and Figure 1 of Park. However, to meet the burden of establishing a *prima facie* case of anticipation, the Office must explain how the rejected claims are anticipated by pointing out where the specific limitations of the claims are found in the prior art. *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (Bd. Pat. App. & Inter.2005). The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. (MPEP §706). The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (37 C.F.R. §1.104(c)(2)). Applicant requests a non-final Office Action with specific identification of each feature or element in the cited reference which is deemed to correspond to the claimed elements and limitations, and if possible the location in the cited reference where the relevant feature or element is discussed.

### The Rejection of Claims 1-5, 19-21 and 28-30 under 35 U.S.C. 102(e)

Claims 1-5, 19-21 and 28-30 stand rejected under 35 U.S.C. 102(e) as being anticipated by Park. This rejection should be withdrawn because Park does not teach each and every aspect of the subject claims and, therefore, does not anticipate the subject claims.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). MPEP §2131.

With respect to **Claim 1** in the response to the previous Office Action, applicants submitted that nowhere in cited sections of Park (paragraphs [0032]-[0049] and Figure 1) does Park teach or suggest a non-volatile storage device, let alone a non-volatile storage device that stores an identification information of a network connection and an information that indicates that an access point for a connection to the network is a hidden access point, where the hidden access point has not issued the identification information. In the subject Office Action, the Office disagrees, asserting that the wireless LAN card 10 stores such information and again broadly citing to paragraphs [0032]-[0049] and Figure 1 without identifying the element(s) of Park which the Office asserts teaches a non-volatile storage device that stores such information. However, these sections of Park clearly are silent and do not contemplate the subject claimed aspect. As such, Park does not anticipate claim 1, and this rejection should be withdrawn.

If the Office is suggesting that the prior art inherently teaches the above claim aspect, then the Office has not met the requisite burden. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. (See MPEP 2112 citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993)). “To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” (See MPEP 2112 citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

The Office has not made clear that the missing descriptive matter is necessarily present or necessarily flows from Park. In fact, Park expressly discloses that for a hidden SSID, the network can only be accessed by a user who knows the SSID (See paragraph [0040]) and that the

LAN card transmits a probe request with a SSID set therein or entered from a user of the user terminal (See paragraph [0041]). Hence, a non-volatile storage device that stores an identification information of a network connection and an information that indicates that an access point for a connection to the network is a hidden access point, where the hidden access point has not issued the identification information, is not necessarily present and does not necessarily flow from Park at least since Park expressly states that such information is entered by the user. Again, this rejection should be withdrawn

**Claim 4**, which depends from claim 1, recites that the non-volatile storage device stores the identification information of the network appended with an order of priority for the connection. The Office asserts this claim aspects is taught in the Abstract, Fig. 4, and paragraphs [0032]-[0049] of Parks. However, none of these sections teaches or suggests appending network identification information with an order of priority for the connection. Moreover, Park is silent regarding an order of priority for network identification information. Hence, this rejection should be withdrawn.

Independent **claim 19** is directed towards a method including, *inter alia*, acquiring from a non-volatile storage device ... information indicating that an access point for connecting to the wireless network is a hidden access point. The Office asserts that this claim aspect is taught the Abstract, Fig. 4, and paragraphs [0032]-[0049] of Parks. However, Park discloses the LAN card scans frequency bands of allowed channels and receives beacon signals transmitted via the respective channels, wherein each of the beacon signals has a frame containing a service set identifier (SSID), which is information enabling identification of network established between a number of access points and a number of clients. (See paragraphs [0037] and [0039]). For security of a network, an SSID record value of a beacon signal is set to "0" to keep an SSID hidden such that only a user who knows the SSID can access the network. (See paragraph [0040]). The wireless LAN card checks and analyzes the SSIDs in the beacon signals and determines if the access point is hidden. (See paragraphs [0037]-[0038] and [0040]). As such, Park learns that an access point is hidden through an SSID in a beacon received from a scanned channel. This does not teach or suggest acquiring from a non-volatile storage device of wireless communications device ... information indicating that an access point for connecting to the wireless network is a hidden access point. Accordingly, this rejection should be withdrawn.

Independent **claim 28** is directed towards a method including, *inter alia*, acquiring from a non-volatile storage device ... information from a connection list table storing the identification information of a wireless network that is not present. As noted *supra*, Park discloses receiving information from a beacon transmitted via a scanned channel that indicates the status of an access point. Accordingly, this rejection should be withdrawn.

**Claim 2-3, 5, 20-21 and 29-30** directly or indirectly depend from independent claims 1, 19 and 28, and are allowable at least by virtue of their dependencies.

### **Conclusion**

In view of the foregoing, it is submitted that the claims distinguish patentably and non-obviously over the prior art of record. Therefore, reconsideration and allowance of the claims is respectfully requested.

Respectfully submitted,

Date: April 28, 2008

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